

REMARKS

Claims 1, 2 and 4-9 are pending. No new matter has been added by way of the present submission. For instance, the specification has been amended to correct minor typographical errors. Additionally, claim 1 has been amended to incorporate the textual subject matter taken from claim 3. Further, claim 3 has been cancelled. Accordingly, no new matter has been added.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Issues Under 35 U.S.C. §102(b) and §103(a)

The Examiner has rejected claims 1-4 and 6-9 under 35 U.S.C. § 102(b) as being anticipated by Inoue et al., USP 4,978,603 (hereinafter referred to as Inoue '603).

The Examiner has also rejected claim 5 under 35 U.S.C. 103(a) as being obvious over Inoue '603 in view of Ichikawa et al., USP 5,270,159 (hereinafter referred to as Ichikawa '159).

Applicants respectfully traverse each of the above rejections.

The present invention relates to a process for the preparation of an emulsion of silver halide fine grains having a number-average equivalent circle diameter of 100 nm or less and coefficient of variation in equivalent circle diameter of 40% or less, wherein the fine grains are prepared via at least one Ostwald ripening step, and wherein the silver halide fine grains

are continuously prepared using a device substantially free of residence portion.

Thus, the invention requires that the silver halide fine grains be continuously prepared using a device substantially free of residence portion. However, the cited primary reference of Inoue '603 fails to suggest or disclose such a limitation. In particular, in the emulsion of Inoue '603, including the Examples of Inoue '603, a silver solution and a halogen solution are added to the container, and the formation of particles is performed in the container. Thus, in Inoue '603, a residence portion exists.

For a rejection to constitute "anticipation", all material elements of a claim must be found in the cited art reference. In re Marshall, 577 F.2d 301, 198 U.S.P.Q. 344 (CCPA 1978). The present claims require that the silver halide fine grains be continuously prepared using a device substantially free of residence portion. However, according to Inoue '603, a residence portion exists. Therefore, an element of the present claims is absent from Inoue '603. Accordingly, based upon this distinction alone, there can be no anticipation of the present claims based upon Inoue '603.

Additionally, there is no obviousness of the present claims based upon Inoue '603 in view of Ichikawa '159. In particular, Ichikawa '159 fails to cure the deficiencies of the Inoue '603 reference discussed above. Absent motivation to substantially eliminate a residence portion, there is no *prima facie* case of

obviousness. At most, modifying the references so as to substantially remove the residence amounts to an "obvious to try" standard, which is improper in the presentation of a *prima facie* case of obviousness. "Obvious to try" is not a valid test of patentability. In re Mercier, 185 USPQ 774 (CCPA 1975); see also Hybritech Inc. v. Monoclonal Antibodies, 231 USPQ 81 (Fed. Cir. 1986). Thus, there is no *prima facie* case of obviousness.

In view of the above, Applicants respectfully submit that the present claims define subject matter which is patentable over the cited art. Accordingly, the Examiner is respectfully requested to withdraw all rejections and allow the currently pending claims.

If the Examiner has any questions or comments, please contact Craig M. McRobbie (Registration No. 42,874) at the offices of Birch, Stewart, Kolasch & Birch, LLP.


Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicants respectfully petition for a three (3) month extension of time for filing a reply in connection with the present application, and the required fee of \$1020.00 is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any

additional fees required under 37 C.F.R. § 1.16 or under § 1.17;  
particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By  #42.874  
f Marc S. Weiner, #32,181

P.O. Box 747  
Falls Church, VA 22040-0747  
(703) 205-8000

MSW/CAM:cms